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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/776,700	02/12/2004	Dinh Duc Nama		3437

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EXAMINER	
LAYNO, BENJAMIN	

ART UNIT	PAPER NUMBER
3711	

DATE MAILED: 08/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/776,700	NAMA, DINH DUC	
	Examiner	Art Unit	
	Benjamin H. Layno	3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 May 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *3-17* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *3-17* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. The amendment filed 05/03/05 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

2. In claims 9-14 the steps of "the player do not need to set the hand when having four of a kind hand", "the player must declare four of a kind hand before house bank or player bank hand exposes", "the player must declare four of a kind hand by expose player's hand", "the player do not declare and expose four of a kind hand will be a losing hand....", "the house banker or player banker do not need to set the hand when having four of a kind hand", and "the player's hand do not need to expose by the card dealer when house banker or player hand having four of a kind hand", **are not described or recited in the original disclosure filed 05/24/04**. These steps are considered new matter.

3. Furthermore, in claim 15, the recitation "the composite deck comprises 12 Jokers", and in claim 17, the recitation "the composite deck comprises 300 cards" **are also not described or recited in the original disclosure filed 05/24/04**, and therefore are also considered new matter.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 9-15 and 17 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the steps recited in claims 3-8 and 16, does not reasonably provide enablement for the steps recited in claims 9-15 and 17, see above. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims. The specification does not provide enablement for the use of the "declaring" and the "setting" of "four of a kind" hands set forth in claims 9-14. Furthermore, the specification does not provide enablement for "the composite deck comprises 12 Jokers" and "the composite deck comprises 300 cards", recited in claims 15 and 17, respectively.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

7. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 7, the recitation "the combined scores are the same as copy hands" is confusing and indefinite.

Response to Arguments

In the Applicant's "Remarks" in the Amendment filed 05/03/05, the Applicant argues by stating:

"We use 12 or 288 cards total. Shen et al. uses a single deck of 52 cards total."

"We play from Ace to Six only; 7 to K are removed. Shen et al. plays from Ace to King."

Etc.

"We play with twelve 12 decks of 288 cards. Nguyen et al. plays with 15 decks or 360 cards."

"Under our invention, any four of kind is the highest hand. Under Nguyen et al., 12 points (6 & 6) is the highest hand."

Etc.

8. In these statements above, the Applicant is arguing against the references **individually**. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on **combinations of references**. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The Applicant's "Remarks" do not include arguments against the Examiners **combination of references**, (e.g. Shen in view of Bacc-Jack and Nguyen). Why would it not be obvious to combine the teachings of Bacc-Jack and Nguyen to come up with a modified Shen game as the Examiner suggested in the last Office action.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 3 and 8-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shen et al..

The patent to Shen et al. discloses a method of playing a card game wherein players play against a house banker or a player banker, col. 1, lines 36. Each player is dealt four cards, and sets two hands, each having two cards, against the house banker or player banker, col. 1, lines 23-24. The player having a winning hand if player's two hands are higher than the house banker's hands. The player having a losing hand if the player's two hands are lower than the house banker's hands. The player having a push hand if one of the player's hands is higher than the house banker's hand, and one hand of the player's hand is lower than the house banker's hand, col. 2, lines 57-61.

The only steps recited in claim 3, that Shen et al. lack are "player having a winning hand if .....one hand is a copy and another hand is higher", and "player having a losing hand if.....one hand is a copy and another hand is lower". In Shen's game the banker wins all ties (copy hands), col. 2, line 65 to col. 3, line 2. The Examiner takes the position that it would have been obvious to a person having ordinary skill in the art modify Shen's rules by requiring that the player having a winning hand if one hand is a copy and another hand is higher, and the player having a losing hand if one hand is a

copy and another hand is lower. This modification would have simply been a casino or house business decision in order to give players the perception of having a higher advantage over the house. Thus, making Shen's game more attractive.

In regard to claim 8, it would have been also obvious to a person having ordinary skill in the art to modify Shen's rules by requiring that all four of a kind have the same ranking. Thus, in Shen's game if both the banker and the player have four of a kind, then it would have been a push. This modification would have simply been a casino or house business decision in order to give players the perception of having a higher advantage over the house. Thus, making Shen's game more attractive.

Concerning claims 9-14, in Shen's game, if a player or the banker receives a four of a kind hand, it would have been obvious to a person having ordinary skill in the art to waive the requirement of setting the cards into two hands. Also, in Shen's game, if a player or a banker receives a four of a kind, it would have been obvious to a person having ordinary skill in the art to require the player or banker to immediately declare the four of a kind. These modifications would have speeded up game, reducing playing time for each round, and thus increasing profits.

11. Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shen et al. as applied to claim 3 above, and further in view of Bacc-Jack.

In regard to claim 4, the game Bacc-Jack teaches that it is known in the card game art where the object is to reach 9 by adding the point values of cards in a player's hand, to provide up to **12 decks of cards**. In view of such teaching, it would have been

obvious to provide up to 12 decks of cards to Shen's game. This modification would have prevented players playing Shen's game from cheating by counting cards. Thus, maintaining the house advantage.

Concerning claim 5, Bacc-Jack also teaches that it is known in the card game art where the object is to reach 9 by adding the point values of cards in a player's hand, to strip certain cards (e.g. 7's, 8's, 9's and 10's) from the deck. In view of such teaching, it would have been obvious to modify the decks in Shen's game by stripping the 7's, 8's, 9's and 10's. Thus, the total number of cards in Shen's game would have been 432 cards (12 decks X 4 suits X 9 cards in each suit). 432 cards is **at least** 288 cards. This modification would have reduced the number of ties in Shen's game, thus making Shen's game more exciting to play.

In regard to claims 6 and 7, Bacc-Jack also teaches that it is known in the card game art where the object is to reach 9 by adding the point values of cards in a player's hand, to not have ordered rankings if combined scores are the same. In view of such teaching, it would have been obvious to a person having ordinary skill in the art to eliminate the ordered rankings (e.g. A & 8 = 9 is the highest hand, K & 9 = 9 is the second highest hand, etc.) in Shen's game. This modification would have made Shen's game less complicated, thus making Shen's game easier to understand and more attractive to play.

12. Claims 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shen et al. in view of Bacc-Jack as applied to claim 4 above, and further in view of Boylan et al.

Concerning claims 15 and 16, the patent to Boylan et al. discloses a card game that uses one or more decks of cards, and there is one Joker included in each deck, col. 3, lines 10-11. Furthermore, it is well known in the card game art to make a Joker wild. In view of such teaching, it would have been obvious to a person having ordinary to include up to 12 Jokers to Shen's deck of playing cards, one Joker would have been included in each deck. This modification would have given players playing Shen's game the perception of having an advantage over the house banker by making Jokers wild thereby receiving higher hands. Thus, making Shen's game more attractive.

In regard to claim 17, 432 cards is **at least** 300 cards, see above.

13. This action is a **final rejection** and is intended to close the prosecution of this application. Applicant's reply under 37 CFR 1.113 to this action is limited either to an appeal to the Board of Patent Appeals and Interferences or to an amendment complying with the requirements set forth below.

If applicant should desire to appeal any rejection made by the examiner, a Notice of Appeal must be filed within the period for reply identifying the rejected claim or claims appealed. The Notice of Appeal must be accompanied by the required appeal fee of $ 165.

If applicant should desire to file an amendment, entry of a proposed amendment after final rejection cannot be made as a matter of right unless it merely cancels claims or complies with a formal requirement made earlier. Amendments touching the merits of the application which otherwise might not be proper may be admitted upon a showing a good and sufficient reasons why they are necessary and why they were not presented earlier.

A reply under 37 CFR 1.113 to a final rejection must include the appeal from, or cancellation of, each rejected claim. The filing of an amendment after final rejection, whether or not it is entered, does not stop the running of the statutory period for reply to the final rejection unless the examiner holds the claims to be in condition for allowance. Accordingly, if a Notice of Appeal has not been filed properly within the period for reply, or any extension of this period obtained under either 37 CFR 1.136(a) or (b), the application will become abandoned.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin H. Layno whose telephone number is (571) 272-4424. The examiner can normally be reached on Monday-Friday, 1st Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on (571)272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Benjamin H. Layno
Primary Examiner
Art Unit 3711

bhl